

## **REMARKS**

Claims 1-8, 11-14, and 17-38 are pending in this application. Claims 9, 10, 15, and 16 have been withdrawn. Applicants reserve the right to reinstate these claims upon a finding of an allowable generic claim. Claim 38 is newly added. Claims 1, 2, 5, 11, 12, 18-20, 23-25, and 31 have been amended. Support for these amendments can be found *e.g.* on page 17, lines 11-18, and Figures 1 and 2. No new matter has been added. Applicants respectfully request reconsideration and allowance of claims 1-8, 11-14, and 17-38.

### **Claim Objections**

Formal objections have been made to claim 31. The Examiner's comments have been considered and appropriate correction has been made. Applicants respectfully submit that the objection is overcome and request withdrawal of the objection.

### **35 U.S.C. § 112**

Claims 5, 11-20, and 23-26 have been rejected under 35 U.S.C. 112, second paragraph, for lack of antecedent basis for various claim terms. Claims 5, 11, 18, and 19 have been amended to delete the term "probe," thereby overcoming the antecedent basis problem. Claim 23 has been amended to depend from claim 22 instead of claim 21. Claim 24 has been amended to recite "command input means," thereby overcoming the antecedent basis problem. Claims 25 and 26 have been amended to recite, "command input members" instead of "control input members." Applicants respectfully submit that these amendments overcome the antecedent basis problems noted by the Examiner. Applicants respectfully request that the rejection with respect to claims 5, 11-20, and 23-26 be withdrawn.

### **35 U.S.C. § 102**

Claims 1, 2, 5-7, 21, and 27 have been rejected under 35 U.S.C. 102(b) as being anticipated by Rovegno (US 6,315,712, hereinafter "Rovegno"). Applicants respectfully submit that the rejection is overcome.

Claim 1 recites, in part, a videoendoscope including an inspection probe, a video processor for generating a video signal, and a control unit provided with controls for controlling

and adjusting the video processor. The videoendoscope further includes an umbilical connection cable secured to the control unit, a display unit connected to the video processor, and a bundle of lighting. The display unit is secured to a side face of the control unit to form an assembly configured to be held in one hand and actuated while being held in said hand. The control unit includes controls for controlling and adjusting the video processor. The assembly is suitable for being held in said hand while the control members are actuated by using the thumb of said hand.

In contrast, Rovegno discloses a video endoscopic probe including a tubular handle 5 for supporting the probe. See, *e.g.*, col. 13, lines 15-18, and Figures 1 and 2. The tubular handle 5 is coupled to a box 4 housing a video processor 9 and a display monitor 10. See, *e.g.*, col. 13, lines 1-7. Controls 13 for controlling the video processor 9 are located on the box 4. The umbilical cord 6 is attached to the tubular handle 5 and not to the box 4. See, *e.g.*, col. 13, lines 18-19.

Rovegno does not disclose or suggest an assembly formed from a display and control unit suitable for being held in one hand while controls for the video processor are actuated using the thumb of the hand. Rather, the tubular handle 5, which does not include a display unit, is configured to be held using one or both hands. Furthermore, no motivation is provided in Rovegno to modify the endoscopic probe to enable the box 4 to be held instead of tubular handle 5. For at least these reasons, therefore, Rovegno does not anticipate claim 1. Applicants respectfully request reconsideration and allowance of claim 1.

Claims 2, 5-7, 21, and 27 depend from claim 1, and are allowable for at least the same reasons. Applicants respectfully request reconsideration and allowance of claims 2, 5-7, 21, and 27.

In addition, claim 2 recites the videoendoscope of claim 1, wherein the umbilical cable and the inspection tube are adjacent. In contrast, Rovegno discloses a probe having an inspection tube attached to a first end of a pistol-shaped control handle. A second, opposite end of the pistol-shaped control handle forms a tubular handle, by which the probe is held. The umbilical cable in Rovegno is attached to the distal end of the tubular handle. Rovegno, therefore, does not disclose or suggest a videoendoscope in which the umbilical cable and the inspection tube are adjacent. For at least these additional reasons, Rovegno does not anticipate claim 2.

**35 U.S.C. § 103**

Claims 3 and 4 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Rovegno in view of Green (US 5,928,137, hereinafter "Green"). Applicants respectfully submit that the rejection is overcome.

Claims 3 and 4 depend from claim 1 and are allowable over Rovegno for at least the same reasons as discussed above with respect to claim 1. Green does not overcome the shortcomings of Rovegno. Green discloses a video endoscope including a flat panel video display means attached to a cylindrical tube. See, *e.g.*, col. 6, lines 4-15, and Figures 1, 3-8, and 34. The handle functions as control means for the inspection portion of the probe. See, *e.g.*, col. 7, lines 40-46. Green does not disclose or suggest an assembly formed from a display and control unit suitable for being held in one hand while controls for a video processor are actuated using the thumb of said hand. The display in Green is not combined with a control unit to form an assembly. Rather, the display is merely attached to the cylindrical tube of the probe and is not directly held. For at least these reasons, therefore, Rovegno would not lead a person having skill in the art to the invention of claims 3 and 4, even in view of Green.

Claims 11, 14, and 20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Rovegno in view of Yokota (US 2003/0060681, hereinafter "Yokota"). Applicants respectfully submit that the rejection is overcome.

Claims 11, 14, and 20 depend from claim 1 and are allowable over Rovegno for at least the same reasons as discussed above with respect to claim 1. Yokota does not overcome the shortcomings of Rovegno. Yokota discloses an endoscope coupled to a remote controller 13 and a separate LCD display 14. See, *e.g.*, paragraphs [0059] and [0062], and Figures 1 and 3. Yokota does not disclose or suggest an assembly formed from a display and control unit suitable for being held in one hand while controls for a video processor are actuated using the thumb of said hand. For at least these reasons, therefore, Rovegno would not lead a person having skill in the art to the invention of claims 11, 14, and 20, even in view of Yokota.

Claims 17 and 18 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Rovegno in view of Yokota, and further in view of Steinberg (US 5,630,783, hereinafter "Steinberg"). Applicants respectfully submit that the rejection is overcome.

Claims 17 and 18 depend from claim 11 and are allowable over the combination of Rovegno and Yokota for at least the same reasons as discussed above with respect to claim 11.

Steinberg does not overcome the shortcomings of Rovegno and Yokota. Steinberg is directed towards a portable cystoscope including a self-contained light source. See, *e.g.*, col. 2, lines 50-54. Steinberg does not disclose or suggest an assembly formed from a display and control unit suitable for being held in one hand while controls for a video processor are actuated using the thumb of said hand. In fact, the cystoscope includes an eyepiece on one end of the cystoscope instead of a display unit and video processor. See, *e.g.*, col. 4, lines 25-37. For at least these reasons, therefore, Rovegno would not lead a person having skill in the art to the invention of claims 17 and 18, even in view of Yokota and Steinberg.

Claim 19 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Rovegno in view of Yokota, and in further view of Kovalcheck (US 5,549,542, hereinafter "Kovalcheck"). Applicants respectfully submit that the rejection is overcome.

Claim 19 depends from claim 11 and, therefore, is allowable over the combination of Rovegno and Yokota for at least the same reasons as discussed above with respect to claim 1. Kovalcheck does not overcome the shortcomings of Rovegno and Yokota. Kovalcheck discloses a minimally intrusive endoscope having a flexible tip. A camera is located on a distal end of the insertion tube. Kovalcheck does not disclose or suggest an assembly formed from a display and control unit suitable for being held in one hand while controls for a video processor are actuated using the thumb of said hand. For at least these reasons, therefore, Rovegno would not lead a person having skill in the art to the invention of claim 19, even in view of Yokota and Kovalcheck.

Claims 22-24 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Rovegno in view of Wood et al. (US 4,941,454, hereinafter "Wood"). Applicants respectfully submit that the rejection is overcome.

Claims 22-24 depend from claim 1 and, therefore, are allowable over Rovegno for at least the same reasons as discussed above with respect to claim 1. Wood does not overcome the shortcomings of claim 1. Wood does not disclose or suggest an assembly formed from a display and control unit suitable for being held in one hand while controls for a video processor are actuated using the thumb of said hand. Rather, Wood is directed towards a steering mechanism for an endoscope. For at least these reasons, therefore, Rovegno would not lead a person having skill in the art to the invention of claims 22-24, even in view of Wood.

Claims 21, 25, 26, 28, and 30 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Rovegno in view of Hibino *et al.* (US 4,982,725, hereinafter "Hibino"). Applicants respectfully submit that the rejection is overcome.

Claims 21, 25, 26, 28, and 30 depend from claim 1 and, therefore, are allowable over Rovegno for at least the same reasons as discussed above with respect to claim 1. Hibino does not overcome the shortcomings of Rovegno. Hibino does not disclose or suggest an assembly formed from a display and control unit suitable for being held in one hand while controls for a video processor are actuated using the thumb of said hand. Rather, Hibino is directed towards an endoscope configured to bend only up to a predetermined angle. See, *e.g.*, col. 2, lines 20-40. For at least these reasons, therefore, Rovegno would not lead a person having skill in the art to the invention of claims 21, 25, 26, 28, and 30, even in view of Hibino.

Claim 29 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Rovegno in view of Suzuki *et al.* (US 5,658,238, hereinafter "Suzuki"). Applicants respectfully submit that the rejection is overcome.

Claim 29 depends from claim 1 and, therefore, is allowable for at least the same reasons as discussed above with respect to claim 1. Suzuki does not overcome the shortcomings of Rovegno. Suzuki does not disclose or suggest an assembly formed from a display and control unit suitable for being held in one hand while controls for a video processor are actuated using the thumb of said hand. Rather, Suzuki is directed towards an endoscope capable of returning to a neutral angle in response to a single touch by a user. Furthermore, the display unit disclosed in Suzuki is a monitor and so is not designed to be held in one hand. For at least these reasons, therefore, Rovegno would not lead a person having skill in the art to the invention of claim 29, even in view of Suzuki.

### **New Claim**

New claim 38 recites, in part, a videoendoscope including a substantially rectangular-shaped housing configured to be held in one hand. The rectangular-shaped housing includes a top surface and side surfaces, the top surface of the housing including a display screen and a control panel. One of the sides of the housing is secured to an inspection probe and another side of the housing is secured to an umbilical cable. The housing further including a video processor for generating a video signal for display on the display screen. The control panel including

controls for controlling and adjusting the video processor. The controls are arranged and configured to be actuated by using the thumb of one hand while the rectangular-shaped housing is being held by that hand.


Applicants respectfully submit that claim 38 is allowable over the cited references for at least the same reasons as discussed above with respect to claim 1. Furthermore, none of the cited references disclose or suggest a rectangular-shaped housing including a display screen and controls for a video processor where the rectangular-shaped housing is designed to be held in one hand while controls on a surface of the housing are actuated using the thumb of the hand. Moreover, none of the references can be used in such a manner. Applicants, therefore, respectfully request examination and allowance of claim 38.

In view of the above amendments and remarks, Applicants respectfully request a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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